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Patent
Attorney Docket No. GEMS8081.045

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Gupta et al.
Serial No. : 09/748,520
Filed : December 22, 2000
For : METHOD AND APPARATUS FOR DISPLAYING
REAL-TIME STATUS OF PRODUCT AVAILABILITY,
ORDERS, AND SALES REVENUE
Group Art No. : 2171
Examiner : Le, U.

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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Date: November 28, 2005

Signature

Commissioner for Patents
P.O. Box 1450
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REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Dear Sir:

A Notice of Appeal is filed concurrently herewith. Applicant hereby requests pre-appeal review of the final rejection in the above-identified application. No amendments are being filed with this request. The review is requested for the reasons set forth below.

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REMARKS

Claims 1-35 are currently pending in the present application. In the Final Office Action of August 26, 2005, the Examiner maintained the rejection of claims 1-7 and 22-25 under 35 U.S.C. 102(e) as being anticipated by Christensen et al. (US 2002/0156694) and the rejection of claims 8-21 and 26-35 under 35 U.S.C. 103(a) as being unpatentable over Christensen et al. in view of Parad (USP 5,369,570).

Responsive to an Office Action mailed October 4, 2003 and rejections based in whole or in part on Christensen et al. stated therein, Applicant filed with the Response of December 31, 2003, a Declaration under 37 C.F.R. §1.131 executed by Inventor Yenerich. The Declaration included an Exhibit A attached thereto identified as a disclosure of the invention to the inventors' employer. In the body of the Declaration document, addressing that which is disclosed in Exhibit A, Inventor Yenerich affirmatively stated that the inventors of the above-captioned application, prior to December 12, 2000 -- the filing date of Christensen et al. -- conceived in the United States, the invention as set forth in the claims of the present Application.

Thereafter, in an Office Action mailed April 30, 2004, the Examiner accepted the Declaration and Exhibit as sufficient to establish a date of priority before the earliest date of Christensen et al. Specifically, the Examiner stated "[t]he affidavit filed on 31 December 2003 under 37 CFR 1.131 is sufficient to overcome the Christensen et al (US 2002/0156694) reference." Office Action of April 30, 2004, p. 2, ¶1. Subsequent thereto, the Examiner indicated the allowability of claims 1-35 in an Ex parte Quayle Action mailed January 12, 2005. In the Ex parte Quayle Action of January 12, 2005 the Examiner requested "a mapping of features claimed with features shown in Exhibit A" and suggested Applicant "submit[s] a copy of the specification drafted before 12 December 2000 since the application was filed ten day later, on 22 December 2000." Ex parte Quayle Action of January 12, 2005, p. 2, ¶2. Responsive thereto, in the Response of February 1, 2005, Applicant directed the Examiner's attention to the indication of allowability of the claims over Christensen et al. and MPEP §701.02(b) which sets forth the formal matters which are addressable with Ex Parte Quayle practice. The scope of the Examiner's request is not supported by Ex parte Quayle practice and the Declaration had been indicated as acceptable.

Subsequent thereto, in the Office Action of April 25, 2005, the Examiner re-opened prosecution and reinstated the rejection of claims 1-35 over Christensen et al. stating that "Applicant argues that the request of the examiner is unusual and has not provided the information requested. Therefore, the Quayle action ... is withdrawn" and the "[r]ejection of claims 1-35 using Christensen et al is reinstated." Office Action of April 25, 2005, p. 2, ¶4. That is, rather than providing any support for why the previously accepted Declaration is now considered "defective", the Examiner reopened

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prosecution because Applicant did not provide documents which the Examiner has no basis to demand.

The Examiner maintains the rejections of the pending claims as unpatentable over Christensen et al. stating that "[t]here is no complete disclosure to another of the claimed 'counting a number of days between a current date and the date when the product will be ready for shipment to create a number of days before the product is available and displaying a listing of each product when the product is available'." The Examiner's conclusion requires complete disregard for that which Inventor Yenerich attests to in the §1.131 Declaration and requires verbatim analysis of that which is disclosed in the Exhibit.

Title 37 C.F.R. §1.131(a) states that "[w]hen any claim of an application ... is rejected, the inventor of the subject matter of the rejected claim... may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based." Title 37 C.F.R. 1.131(b) further states that "[o]riginal exhibits of drawings or records, or photocopies thereof, must accompany and form part of the... declaration or their absence must be satisfactorily explained." (Emphasis added) That is, not only can a Declaration be filed without supplemental documentation if satisfactory explanation is provided as to the absence of the documentation, the supplemental documentation or exhibits are only part of evidence considered when reviewing the declaration. The exhibit need not include the text of the claims. To require such is, at a minimum, impractical, but more likely is an unsatisfiable requirement since claims are usually drafted by an attorney and disclosure/evidence is drafted by an inventor at dates that predate even the thought of the claim.

MPEP §715.07.1 further states that "when reviewing a 37 CFR 1.131 ... declaration, the examiner must consider all of the evidence presented in its entirety, including the ... declarations and all accompanying exhibits, records and 'notes'" and that "[a]n accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself." (Emphasis added)

Even though previously accepted, the Examiner now maintains that the Declaration and documentation filed December 31, 2003 is inadequate to establish a date of invention prior to December 12, 2000 because "[t]here is no complete disclosure to another of the claimed 'counting a number of days between a current date and the date when the product will be ready for shipment to create a number of days before the product is available and displaying a listing of each product when the product is available'."

First, there is no requirement that there be a disclosure to another and the Examiner has not provided any support for such a requirement. Second, contrary to the Examiner's assertion, in the body of the Declaration, Inventor Yenerich attests to conception of a method for displaying real-time

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status of product availability including automatically querying a database, for data about a plurality of products that are scheduled for production, at regular time intervals for a date when each product will be ready for shipment for a plurality of products, and if the date does not exist, skipping that product. Otherwise, if a date exists, for each product, counting a number of days between a current date and the date when the product will be ready for shipment to create a number of days before the product is available and displaying a listing of each product and when the product is available for shipment for product availability management. A comparison of the underlined clauses above evidences Inventor Yenerich's understanding that the claims as presently pending are a textualization of that which is shown and described in the Exhibit filed with the Declaration. That is, a portion of the evidence submitted with the Declaration is Inventor Yenerich's attestation that, prior to December 12, 2000, he and his co-inventors invented that which is called for in the present claims. The Examiner's rejection of the present claims as unpatentable over Christensen et al. requires complete disregard of the evidence provided in the body of the Declaration. Such disregard is expressly prohibited under MPEP §715.07.I.

Third, the Examiner's allegation that Exhibit A submitted with the Declaration filed December 31, 2003 is insufficient to prove a date of conception at least prior to the date of priority of Christensen et al. is only supported with a verbatim analysis of the Exhibit. That is, the Examiner has afforded no degree of interpretation of that which is disclosed in the Exhibit beyond the specific terms used therein. The Examiner has improperly discounted and dismissed Applicant's 131 Declaration under the mistaken belief that the supporting evidence must recount claim verbiage word for word and regardless of what the Declaration sets forth. It appears as though the Examiner has concluded that which is called for in the claims is not shown in the Exhibit merely because the Examiner's word search thereof failed to elicit the complained of clause. Absent the Examiner's unduly, unauthorized, and constrictive verbiage requirement, that which is claimed is disclosed in the Exhibit.

As shown in the exemplary screen capture on page 5 of the Exhibit, the present invention includes an "Offering window" along with a sub-menu associated with the selected offering. As shown therein, the "CT Offering" includes an "LCAT Number" column and a "Status" column associated therewith. As shown in the "Status" column, the Exhibit shows conception of several status identifiers including an "Immediate Shipment" status, a "Call for Availability" status, and a "Shipment within 90 Days" status. The Exhibit discloses counting a number of days between a current date and the date when the product will be ready for shipment to create a number of days before the product is available by disclosing the determination of the "Status" shown in the exemplary screen capture on page 5 of the Exhibit. That is, by displaying that a product "Status" is available for immediate shipment, is a call for availability, or that there will be a shipment in 90 days, the Exhibit discloses that which is claimed. That is, in determining which, if any, of these exemplary "Status"

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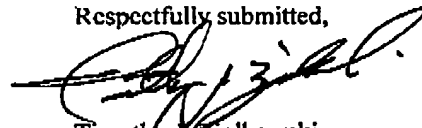
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identifiers is applicable to a specific order, the present date must be determined, a date when the specific order is going to ship must be determined, and the number of days between these two dates must be counted or calculated to determine which "status" of the exemplary status identifiers is applicable to a specific order. For example, for a product to be associated with a Status of "Shipment within 90 days" the Exhibit discloses counting a number of days between today (a current date) and the date when the product will be ready for shipment (within 90 days), creating a number of days (within 90 days) before the product is available, and displaying a listing of each product (the LCAT Number) and when the product is available (immediately or within 90 days). Accordingly, contrary to the Examiner's present interpretation thereof, Applicant believes, as the Examiner previously stated, the Declaration filed on 31 December 2003 under 37 CFR 1.131 is sufficient to overcome the Christensen et al (US 2002/0156694) reference.

Consideration of all of the evidence of the Declaration of December 31, 2003, entitles Applicant to a date of conception prior to at least December 12, 2000. Accordingly, Applicant believes that a date of conception prior to December 12, 2000 has been established in the above-captioned matter by consideration of all of the evidence filed in the Declaration of December 31, 2003 including the Declaration and the Exhibits attached thereto. Further, having established a date of conception prior to December 12, 2000, rejections based in whole or in part on Christensen et al., having a provisional filing date of December 12, 2000, are improper. As all of the outstanding rejections are based in whole or in part on Christensen et al., and Applicant has proven a date of conception prior to the filing date of Christensen et al., Applicant believes that the claims of the present Application are in condition for allowance.

Applicant appreciates the panel's review. In light of at least the foregoing, Applicant respectfully requests reversal of the Examiner's rejections and timely issuance of a Notice of Allowance for claims 1-35.

Respectfully submitted,



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